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P. #8
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: L. Whiteside

GROUP ART UNIT: 3308

SERIAL NO.: 08/466,607

EXAMINER: B. Snow

FILED: 06/06/95

DOCKET NO.: 952393/6217

FOR: Acetabular Component With Improved Liner Seal and Lock

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

AMENDMENT B
(37 CFR § 1.116)

SIR:

In response to the outstanding Office action, please enter the following amendments in order to place the application in condition for allowance or appeal:

In the specification:

Please amend the specification as follows:

Page 6, line 32, after "peripheral edge", please delete "as is described in greater detail, infra" and insert therefor -- which is relatively flat, and smooth as best seen in Figure 2.--;

Page 8, line 27, before "tapered", please insert --smooth--;

Page 8, line 30, please delete "sloped" and insert therefor --smooth tapered--;

Page 9, line 3, delete "sloped" and insert therefor -- smooth tapered--.

In the claims:

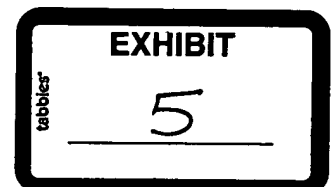
Please cancel claims 1, 4, 5, 8, 9, and 11 - 15.

Please add the following new claim:

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on *9/26/96*
Gregory E. Hight
Sept. 26, 1996
Office of Signature

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To further prevent micromotion between the liner 42 and the shell 32, each notch 36 may be provided with protruding lips 78, 80 as shown in the alternative construction in Figure 3. These lips 78, 80 project into the notches 36 and firmly grasp the tabs upon insertion of the liner 42 into the shell 32. In this manner, relative motion, or micromotion, between the liner 42 and the shell 32 is further substantially inhibited. Alternatively, the tabs 60 of the liner 42 could be lipped, and the notches 36 could have tapered sides, or the shell 32 could be provided with tabs 60 and the liner 42 provided with notches 36, with either the tabs 60 or the notches 36 being lipped, possibly in conjunction with tapered sides of the non-lipped member for ease of insertion.

While the liner 42 has been described as being formed from polyethylene, liners comprising other types of materials can also be used with the present invention where similar problems with debris generation or migration exist, or where sealing between the liner 42 and shell 32 is otherwise necessary.

To implant the acetabular components of the present invention, an appropriately sized component must be selected with consideration of anatomical and biomedical factors such as the patient's age, activity levels, weight, and bone and muscle conditions. Preparation of the acetabular cavity is necessary prior to insertion of the component. Thereafter, the acetabular shell can be inserted into the cavity and attached by any of the means described above. Where bone screws or modular pegs are to be utilized, the acetabular shell must be affixed prior to inserting the liner into the shell. Inserting the liner into the shell typically requires impacting the liner, which will cause the annular seal ridges to flex. The interlock ridge must also be forced past the outer lip of the shell and into

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the interlock groove which seats the liner in the shell, the seal, and the tabs into the notches. At that time, the annular seal ridges, due to their resiliency, will be in sealing engagement with the annular seal surface,

5. thereby substantially preventing a migration of debris between the liner and shell. Meanwhile, the tabs of the liner have an interference fit into the notches, with the lips of each notch firmly grasping its respective tab (alternative embodiment), thereby substantially
- 10 inhibiting micromotion between the liner and the shell.

While the prosthesis component of the present invention has been described as an acetabular component for a hip replacement system, this description is not intended to be limiting. The prosthesis component of the

15 present invention can be utilized in other articulating anatomical joint systems, such as shoulder joint systems, and not limited to ball and socket joints, and is equally suited for other types of uses, including veterinarian applications.

- 20 There are various changes and modifications which may be made to the invention as would be apparent to those skilled in the art. However, these changes or modifications are included in the teaching of the disclosure, and it is intended that the invention be
- 25 limited only by the scope of the claims appended hereto.

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What is Claimed is:

Sub A1
1. In a prosthesis including a shell, and a liner which is received by said shell, the improvement comprising a seal between said shell and liner to restrict migration of foreign material between said liner and shell.

Sub B2
2. The prosthesis of Claim 1 wherein said prosthesis is load bearing, said liner being formed to substantially conform to and contact said shell under load bearing conditions, and said seal being positioned to maintain its sealing engagement between said liner and shell under load bearing conditions.

3. The prosthesis of Claim 2 wherein said seal includes at least one ridge of resilient material so that load bearing contact between said liner and said shell brings said ridge into sealing engagement therebetween.

4. The prosthesis of Claim 3 wherein said at least one ridge is formed as part of said liner.

Sub A8
5. The prosthesis of Claim 4 wherein said shell includes a surface for receiving said at least one ridge.

6. The prosthesis of Claim 5 wherein each of said at least one ridges is an annulus integrally formed on said liner, and said surface is sized and spaced to receive all of said at least one ridges, said seal thereby restricting migration of foreign material from outside of said shell/liner interface to the interior of said shell/liner interface.

7. The prosthesis of Claim 5 wherein said shell includes at least one opening and said seal surrounds said at least one openings to thereby prevent foreign material from passing therethrough.

8. The prosthesis of Claim 1 further comprising a plurality of peripheral tabs on one of said liner or shell, and a plurality of peripheral notches on the other of said liner or shell, said tabs and notches being

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5 located to engage as said ~~liner~~ ^B is inserted in said shell.

9. The prosthesis of Claim 8 wherein said tabs and notches are sized to interference fit as they engage.

Sub A3
10. The prosthesis of Claim 9 wherein said notches include protruding lips to grasp said tabs as they engage.

11. The prosthesis of Claim 1 further comprising an interlock between said liner and said shell, said interlock being located to engage as said liner reaches its desired location in said shell.

12. The prosthesis of Claim 11 wherein said interlock includes an interlock ridge on one of said liner or shell, and an interlock groove on the other of said liner or shell, said interlock ridge and interlock 5 groove being sized and located to engage as said liner is inserted fully into said shell and bottoms therein.

Sub A4
13. An acetabular component including a generally hemispherically shaped shell and a generally hemispherically shaped liner for being received in said shell, and a seal between said liner and shell for 5 restricting migration of foreign material between said liner and said shell.

14. The acetabular component of Claim 13 wherein said liner is shaped to seat ^B along substantially its entirety within said shell, said seal maintaining sealing engagement between said liner and shell as said liner 5 seats in said shell.

Sub A5
15. The acetabular component of Claim 14 wherein said seal includes a plurality of annular shaped ridges formed on said ^A liner and said shell includes an inner surface upon against said ridges rest as said liner seats 5 in said shell to thereby sealingly engage said liner to said shell.

Add B'

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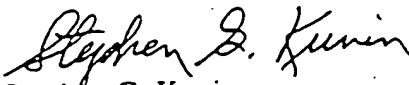


MEMORANDUM

Solicitor
PARK 2-918
29 Employees

Date: September 21, 1999

To: Patent Examining Corps

From: 
Stephen G. Kunin
Deputy Assistant Commissioner for Patent Policy and Projects

Subject: Applying the Recapture Rule to Reissue Applications

The following material provides guidance to the patent examining corps in applying the recapture rule to reissue applications. The substance of the material will be incorporated into Chapter 1400 of the MPEP in the next revision.

RECAPTURE OF SURRENDERED SUBJECT MATTER

A reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent- *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); *In re Richman*, 409 F.2d 269, 276, 161 USPQ 359, 363-364 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960).

TWO STEP TEST FOR RECAPTURE:

In *Clement*, 131 F.3d at 1468-69, 45 USPQ2d at 1164, the Court of Appeals for the Federal Circuit set forth guidance for recapture as follows:

The first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation's aspect.... Under *Mentor* [*Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993)], courts must determine in which aspects the reissue claim is broader, which includes broadening as a result of an omitted limitation....

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an

applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. See *Mentor*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984).

In every reissue application, the examiner must first review each claim for the presence of broadening, as compared with the scope of the claims of the patent to be reissued. A reissue claim is broadened where some limitation of the patent claims is no longer required in the reissue claim; see MPEP § 1412.03 for guidance as to the nature of a "broadening claim."

Where a claim in a reissue application is in fact broadened, the examiner must next determine whether the broader aspects of that reissue claim relate to subject matter that applicant previously surrendered during the prosecution of the original application (which became the patent to be reissued). Each limitation of the patent claims, which is omitted or broadened in the reissue claim, must be reviewed for this determination.

It is noted that the facts in *Hester* and *Clement* (and the other cases cited above) were directed to subject matter surrendered in response to art rejections. The question as to whether other rejections may also give rise to recapture, however, remains unsettled in the case law.

CRITERIA FOR DETERMINING THAT SUBJECT MATTER HAS BEEN SURRENDERED:

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.

The examiner should review the prosecution history of the original application file (of the patent to be reissued) for recapture. The prosecution history includes the rejections and applicant's arguments made therein. The record of the original application must show that the broadening aspect (the omitted/broadened limitation(s)) relates to subject matter that applicant previously surrendered. For example:

1) A limitation of the patent claims is omitted in the reissue claims. This omission provides a broadening aspect in the reissue claims, as compared to the claims of the patent. The omitted limitation was originally argued in the original application to make the application claims allowable over a rejection or objection made in the application. Thus, the omitted limitation relates to subject matter previously surrendered, in the original application.

Note: The argument that the claim limitation defined over the rejection must have been specific as to the limitation; rather than a general statement regarding the claims

as a whole. In other words, a general "boiler plate" sentence will not be sufficient to establish recapture. An example of one such "boiler plate" sentence is:

"In closing, it is argued that the limitations of claims 1-7 distinguish the claims from the teachings of the prior art, and claims 1-7 are thus patentable."

This general "argument" will not, by itself, be sufficient to establish surrender and recapture.

2) The limitation omitted in the reissue was added in the original application claims for the purpose of making the claims allowable over a rejection or objection made in the application. Even though applicant made no argument on the record that the limitation was added to obviate the rejection, the nature of the addition to the claim can show that the limitation was added in direct reply to the rejection. This too will establish the omitted limitation as relating to subject matter previously surrendered. To illustrate this, note the following example:

The original application claims recite limitations A+B+C, and the Office action rejection combines two references to show A+B+C. In the amendment replying to the Office action, applicant adds limitation D to A+B+C in the claims, but makes no argument as to that addition. The examiner then allows the claims. Even though there is no argument as to the addition of limitation D, it must be presumed that the D limitation was added to obviate the rejection. The subsequent deletion of (omission of) limitation D in the reissue claims would be presumed to be a broadening in an aspect of the reissue claims related to surrendered subject matter.

3) The limitation A omitted in the reissue claims was present in the claims of the original application. The examiner's reasons for allowance in the original application stated that it was that limitation A which distinguished over a potential combination of references X and Y. Applicant did not present on the record a counter statement or comment as to the examiner's reasons for allowance, and permitted the claims to issue. The omitted limitation is thus established as relating to subject matter previously surrendered.

ARGUMENT (WITHOUT AMENDMENT TO THE CLAIMS) IN THE ORIGINAL APPLICATION MAY BE SUFFICIENT TO ESTABLISH RECAPTURE:

In *Clement*, the recapture was directed to subject matter surrendered in the original application by **changes** made to the claims (i.e., amendment of the claims) in an effort to overcome a prior art rejection. The *Clement* Court, however, also stated that "[t]o determine whether an applicant surrendered particular subject matter, we look to the prosecution history for **arguments** and changes to the claims made in an effort to overcome a prior art rejection." [Emphasis added] 131 F.3d at 1469, 45 USPQ2d at 1164. This statement in *Clement* was subsequently discussed in *Hester Industries, Inc. v. Stein, Inc.*, *supra*, where the Court observed that surrender of claimed subject matter may occur by *arguments* made during the prosecution of the original patent application *even where there was no claim change made*. The Court in *Hester* held that the surrender which forms the basis for impermissible recapture "can occur

through arguments alone." 142 F.3d at 1482, 46 USPQ2d at 1649. Accordingly, where claims are broadened in a reissue application, the examiner should review the prosecution history of the original patent file for recapture, even where the claims were never amended during the prosecution of the application which resulted in the patent.

REISSUE CLAIMS ARE SAME OR BROADER IN SCOPE IN ALL ASPECTS:

The recapture rule bars the patentee from acquiring through reissue claims that are, in all aspects, of the same scope as, or are broader in scope than, those claims canceled from the original application to obtain a patent. *Ball*, 729 F.2d at 1436, 221 USPQ at 295.

REISSUE CLAIMS ARE NARROWER IN SCOPE IN ALL ASPECTS:

The patentee is free to acquire, through reissue, claims that are narrower in scope in all aspects than claims canceled from the original application to obtain a patent. If the reissue claims are narrower than the claims canceled from the original application, yet broader than the original patent claims, reissue must be sought within 2 years after the grant of the original patent. *Ball*, 729 F.2d at 1436, 221 USPQ at 295. See MPEP § 1412.03 as to broadening claims.

REISSUE CLAIMS ARE BROADER IN SOME ASPECTS, BUT NARROWER IN OTHERS:

Reissue claims that are broader in certain aspects and narrower in others *vis-à-vis* claims canceled from the original application to obtain a patent may avoid the effect of the recapture rule if the claims are broader in a way that does not attempt to reclaim what was surrendered earlier. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). "[I]f the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; [] if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible." *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165.

If the broadening aspect of the reissue claim relates to subject matter previously surrendered, the examiner must determine whether the newly added narrowing limitation in the reissue claim modifies the claim such that the scope of the claim no longer results in a recapture of the surrendered subject matter. If the narrowing limitation modifies the claim in such a manner that the scope of the claim no longer results in a recapture of the surrendered subject matter, then there is no recapture. In this situation, even though a rejection based on recapture is not made, the examiner should make of record the reason(s) why, as a result of the narrowing limitation, there is no recapture.

REISSUE TO TAKE ADVANTAGE OF 35 U.S.C. 103(b):

A patentee may file a reissue application to permit consideration of process claims which qualify for 35 U.S.C. 103(b) treatment if a patent is granted on an application entitled to the benefit of 35 U.S.C. 103(b), without an election having been made as a result of error without deceptive intent. See MPEP § 706.02(n). This is not to be considered a recapture. The addition of process claims, however, will generally be considered to be a *broadening* of the invention (*Ex Parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

REISSUE FOR ARTICLE CLAIMS WHICH ARE FUNCTIONAL DESCRIPTIVE MATERIAL STORED ON A COMPUTER-READABLE MEDIUM:

A patentee may file a reissue application to permit consideration of article of manufacture claims which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. The error in not presenting claims to this statutory category of invention (the "article" claims) must have been made as a result of error without deceptive intent. The addition of these "article" claims will generally be considered to be a *broadening* of the invention (*Ex Parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

REJECTION BASED UPON RECAPTURE:

Reissue claims which recapture surrendered subject matter should be rejected using form paragraph 14.17 as follows. < Note: the MPEFP has not yet been revised to include this version of 14.17 >

¶ 14.17 Rejection, 35 U.S.C. 251, Recapture

Claim [1] rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

[2]

Examiner Note: In bracket 2, the examiner should explain the specifics of why recapture exists, including an identification of the omitted/broadened claim limitations in the reissue which provide the "broadening aspect" to the claim(s), and where in the

original application the narrowed claim scope was presented/argued to obviate a rejection/objection. See MPEP 1412.02.

EXAMPLES:

The following examples illustrate recurring fact situations presenting recapture issues and their resolution. It should be noted that each recapture issue should be decided on a case-by-case basis.

Bread compositions and bread making are used in the examples for ease of comparison, and so that the reader need not adjust to a very different fact pattern for different examples.

Example 1- Recapture based on claim limitations added in original application to overcome prior art:

Original prosecution:

An application was filed containing only one claim reciting:

Claim 1: A bread containing chocolate, pepper, and tomatoes, which provide a unique taste to the bread.

During the original prosecution, the examiner issued an Office action rejecting claim 1 based upon references X and Y which together teach a bread having chocolate, pepper, and tomatoes.

In an amendment replying to the Office action, applicant added (from the specification) "orange peels" to claim 1 and argued that the amendment overcame the rejection based on references X and Y. The claim, as amended, recited:

Claim 1 (once amended): A bread containing chocolate, pepper, tomatoes and orange peels, which provide a unique taste to the bread.

The examiner allowed the claim and passed the application to issue. A patent then issued on the application.

Reissue proceedings:

In a reissue application, new claim 2 is presented for a bread containing chocolate, pepper, and tomatoes, which provide a unique taste to the bread. Because of market place developments which now show the need to claim a bread without "orange peels," new claim 2 does not include the limitation of "orange peels" that defined over references X and Y in the original application.

The reissue oath points out that the original presentation (in the patent) of only a claim which included "orange peels" was "error" upon which reissue may be based; thus, claim 2 which omits "orange peels" is added in the reissue. The oath points out that the error arose because applicant's attorney incorrectly assumed that the

manufacture of the bread without orange peels was not commercially feasible due to the consistency of the resulting bread.

A "commercial success" affidavit is newly presented in the reissue application to show that claim 2 is patentable over references X and Y even without "orange peels." and the examiner deems the affidavit to be persuasive. Accordingly, the examiner determines that claim 2 defines over references X and Y and the remainder of the art.

Resolution of the recapture issue:

Claim 2 would be barred by recapture. The limitation omitted in the reissue is "orange peels." This provides a broadening aspect to the reissue claim that was clearly argued in the original application to overcome the rejection based on references X and Y. Thus, omission of "orange peels" is related to subject matter surrendered in the original application. This is the fundamental case of recapture. Since recapture exists, claim 2 should be rejected under 35 U.S.C. 251 based on recapture in the manner set forth above under the heading "Rejection based upon recapture:".

In this example, applicant narrowed the claims for the purpose of obtaining allowance in the original prosecution, and applicant is now precluded from recapturing subject matter previously surrendered. See also *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993) with respect to this example. (In *Mentor*, there were narrowing limitations added to the reissue claims that did not serve to materially narrow the claims in a manner effective to avoid a recapture bar; however, those narrowing limitations are not included in this example of fundamental recapture.)

Example 2- Recapture based upon applicant's statement made during the original prosecution:

Original prosecution:

An application was filed containing only one claim reciting:

Claim 1: A bread baking oven for baking bread using only steam comprising:

a chamber;

means passing a continuously running conveyor belt through the chamber to expose bread in the chamber only to steam as the sole baking medium;

and means providing two sources of steam to bake the bread:

one being a source of steam comprising a pool of water within the chamber with heating means for boiling the water to create steam,

and the other a steam generator supplying supplemental steam into the chamber to maintain the atmosphere, together with the first steam source, at near 100% humidity, 100 degrees C. and a pressure above atmospheric.

During the prosecution of the original patent, the examiner repeatedly rejected claim 1 based upon prior art references X and Y which together teach the claimed oven. Applicant repeatedly replied with the argument that **baking solely with steam** and the **two sources of steam** limitations distinguished claim 1 from references X and Y, and that each of these limitations are critical to patentability. Applicant did not amend the claim, and ultimately applicant appealed to the Board of Patent Appeals and Interferences. In the appeal, applicant again relied upon the argument of baking solely with steam and the two sources of steam. The Board reversed the examiner, and the examiner passed the application to issue. A patent issued on the application.

Reissue proceedings:

In a reissue application, claim 2 is newly presented containing the same language as in claim 1 except that it does not contain the requirement that **the baking be solely with steam**, and does not require that the steam be generated via **two sources of steam**.

The reissue oath points out that the presentation of only a claim which included these two limitations was "error" by the attorney in failing to recognize the full scope of the invention.

During the prosecution of the reissue application, the examiner is persuaded that claim 2 defines over the prior art.

Resolution of the recapture issue:

Claim 2 is barred by recapture.

In this example, reissue claim 2 is broader than patent claim 1 by the omission of two limitations, **baking solely with steam** and **steam generation via two sources of steam**. Applicant surrendered the claim scope for a bread baking apparatus which omits these two limitations because applicant repeatedly argued during prosecution of the original application (including on appeal) that these two limitations distinguished original claim 1 from references X and Y and that each of the limitations was critical to patentability. These repeated arguments constitute an admission by applicant that the two limitations were necessary to overcome the prior art. Thus, claim 2 is broader than the original application claim in an aspect relevant to prior art rejection and related to the surrendered subject matter. Accordingly, impermissible recapture exists, and claim 2 should be rejected under 35 U.S.C. 251, based upon recapture.

Impermissible recapture exists in this example even though applicant never amended the original application claim to add **baking solely with steam** and **steam generation via two sources of steam**; the two limitations were present in the originally presented claim of the application. Subject matter can be surrendered by way of arguments *or* by claim amendment made during the prosecution of the original patent application. In the present example, applicant's argument provided the basis for a finding of surrender of subject matter.

A similar situation arose in *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998). In *Hester*, however, the reissue claims also included narrowing limitations added via the reissue that did not serve to materially narrow the claims in a manner effective to avoid a recapture bar; those limitations are not included (presented) in this example, since they are not directed to the focus of the example.

Example 3- Reissue broadens, but the broadening is not related to the prior art rejection-No recapture:

Original prosecution:

As in Example 1, an application was filed containing only one claim reciting:

Claim 1: A bread containing chocolate, pepper, and tomatoes, which provide a unique taste to the bread.

During the prosecution, the examiner issued an Office action rejecting claim 1 based upon references X and Y which together teach a bread having chocolate, pepper, and tomatoes.

In an amendment replying to the Office action, applicant added (from the specification) "orange peels" to claim 1 and argued that this amendment overcame the rejection based on references X and Y, in that it provided a sweetness to the bread. The amended claim recited:

Claim 1 (once amended): A bread containing chocolate, pepper, tomatoes and orange peels, which provide a unique taste to the bread.

The examiner allowed the claim and passed the application to issue. A patent issued on the application.

Reissue proceedings:

In a reissue application, new claim 2 is presented.

Claim 2: A bread containing chocolate, tomatoes and orange peels, which provide a unique taste to the bread.

New claim 2 does not include the "pepper" of claim 1 of the original application. The reissue oath points out that limiting the bread to a pepper-containing bread (in the patent) was "error" upon which reissue may be based; thus, claim 2 which omits "pepper" is added in the reissue application. The oath points out that the error arose because applicant's attorney incorrectly assumed that bread with pepper was the only thing applicant was interested in producing.

The examiner determines that claim 2 defines over references X and Y and the remainder of the art, even without the pepper limitation.

Resolution of the recapture issue:

Claim 2 would be not barred by recapture. The limitation omitted in the reissue is "pepper." This provides a broadening aspect to the reissue claim that was never argued in the original application to overcome the rejection based on references X and Y. Thus, omission of "pepper" is not related to subject matter surrendered in the original application: a bread omitting pepper was never surrendered.

Regarding this example, see *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

Example 4(a)- Reissue narrows & broadens, where the broadening is related to the prior art rejection and the narrowing is not-Yes recapture:

Original prosecution:

As in Examples 1 and 3, an application is filed containing only one claim reciting:

Claim 1: A bread containing chocolate, pepper, and tomatoes, which provide a unique taste to the bread.

During the prosecution, the examiner issues an Office action rejecting claim 1 based upon references X and Y which together teach a bread having chocolate, pepper, and tomatoes.

In an amendment replying to the Office action, applicant added (from the specification) "orange peels" to claim 1 and argued that the amendment overcame the rejection based on references X and Y. The claim now recites:

Claim 1(once amended): A bread containing chocolate, pepper, tomatoes and orange peels, which provide a unique taste to the bread.

The examiner allowed the claim and passed the application to issue. A patent issued on the application.

Reissue proceedings:

In a reissue application, a new claim (i.e., claim 2) is presented for a bread containing chocolate, **diced green bell peppers** and tomatoes, which provide a unique taste to the bread. This reissue claim does not contain the "orange peels" that defined over references X and Y in the application. It does, however, require that the pepper be "diced green bell peppers" (unlike the case of example 1). The "diced green bell" limitation of the "pepper" is a limitation which was overlooked in the prosecution of the patent, and as such, constitutes "error" upon which reissue may be based. The examiner determines that newly presented claim 2 defines over references X and Y and the remainder of the art, based upon the "diced green bell peppers".

Resolution of the recapture issue:

Claim 2 would be barred by recapture. The limitation omitted in the reissue is "orange peels." This provides a broadening aspect to the reissue claim that was clearly

argued in the original application to overcome the rejection based on references X and Y. Thus, omission of "orange peels" is related to subject matter surrendered in the original application. A narrowing limitation was also provided in reissue claim 2: i.e., a limitation that limits the "pepper" to "diced green bell peppers." This narrowing limitation, however, is not at all related to the "orange peels" and the manner in which it defined over the art. Since the narrowing is not related to the prior art rejection and not related to the subject matter surrendered in the original application (omission of orange peels), recapture exists and claim 2 should be rejected under 35 U.S.C. 251.

See *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997).

Example 4(b)- Reissue narrows & broadens where both are related to prior art rejections (different ones)-Yes recapture:

Original prosecution:

An application was filed containing only one claim reciting:

Claim 1: A method of treating bread dough to remove seed contaminants contained therein, which comprises:

- (a) forming a flowing dough;
- (b) irradiating the dough to soften the seeds at a temperature above room temperature; and
- (c) adhering the softened seeds to a membrane at a temperature below room temperature and then recovering the dough.

During the prosecution, the examiner issued an Office action rejecting claim 1 based upon references X and Y which together teach steps (a)-(c). Claim 1 was also rejected based upon reference Z which teaches steps (a)-(c) in a somewhat different manner (than references X and Y do).

In an amendment replying to the action, applicant added "101 and 115° C." to step (b) of claim 1, and "5-15° C." to step (c), in place of "a temperature above room temperature" and "a temperature below room temperature," respectively. Applicant argued that the temperature additions define the claim over references X and Y. Applicant also added new step (d) to claim 1, reciting the collecting of the seed-free dough while mixing and irradiating it. Applicant argued this addition to define the claim over reference Z.

The claim now recites:

Claim 1 (once amended): A method of treating a bread dough to remove seed contaminants contained therein, which comprises:

- (a) forming a flowing dough at room temperature;

(b) irradiating the dough to soften the seeds while heating the dough to between 101 and 115° C.;

(c) adhering the softened seeds to a membrane at a temperature of 5-15° C. and then recovering the dough; and

(d) collecting the seed-free dough while mixing and irradiating the dough.

The examiner allowed the claim and passed the application to issue; a patent then issued on the application.

Reissue proceedings:

In a reissue application, claim 2 is now presented containing the same language as in claim 1 except that it does not contain the "101 and 115° C." and 5-15° C." limitations that defined over references X and Y in the application. Added to claim 2 step (d) is the limitation "in a vacuum," so that step (d) now recites-

(d) collecting the seed-free dough in a vacuum while mixing and irradiating the dough.

The reissue oath points out that the presentation (in the patent) of only a claim which included the two temperature limitations was "error" upon which reissue may be based; thus, claim 2 which is free of the temperature limitations is added in the reissue. The reissue oath additionally points out that "in a vacuum" is added because it further defines over reference Z.

The examiner determines that claim 2 defines over references X, Y and Z and the remainder of the art.

Resolution of the recapture issue:

Claim 2 would be barred by recapture:

In this example, reissue claim 2 is both broader and narrower than patent claim 1 in areas relevant to the prior art rejections.

Comparing reissue claim 2 with patent claim 1, claim 2 is narrower in one aspect, namely, the step (d) dough collection "in a vacuum." This narrowing relates to a prior art rejection because, during the prosecution of the patent, applicant added step (d) to overcome reference Z.

Reissue claim 2 is broader in that it eliminates the "101 and 115° C." and 5-15° C." temperature limitations. This provides a broadening aspect to the reissue claim to exclude the temperature limitations that were clearly argued in the original application to overcome the rejection based on references X and Y.

Reissue claim 2 is broader in a manner *directly pertinent to the subject matter that applicant surrendered* during the prosecution (i.e., the method of treating the bread

dough to remove seed contaminants, absent the "101 and 115° C." and 5-15° C." temperature limitations).

The narrowing aspect of reissue claim 2 (requiring a "vacuum") relates to a prior art rejection because, during the prosecution of the patent, applicant added the dough collection limitation (d) in an effort to overcome reference Z. The narrowing does not, however, relate to the prior art rejection which applicant dealt with in the original prosecution by adding the "101 and 115° C." and 5-15° C." temperature limitations (thereby making the temperature limitation surrender). Accordingly, the narrowing limitation cannot save claim 2 from the recapture doctrine.

Since recapture exists, claim 2 should be rejected under 35 U.S.C. 251 as being a recapture.

See *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997).

Example 5- The reissue both broadens and narrows by newly presenting a separate species-Yes recapture

Original prosecution:

The original application claim recited:

Claim 1: A bread containing chocolate, pepper, and tomatoes, which provide a unique taste to the bread.

The specification disclosed that citrus fruit peels provide added texture to the bread. Examples were provided in the specification where "orange peel" and "lemon peel" are used for texture. Note, however, that citrus fruit peels were not included as a component of the only claim in the case.

In the amendment replying to the Office action, applicant added "orange peels" to claim 1. Applicant argued that "orange peels" define the claim over references X and Y, because the orange peels make the bread sweeter. The amended claim recited:

Claim 1 (once amended): A bread containing chocolate, pepper, tomatoes and **orange peel**, which provide a unique taste to the bread.

Reissue proceedings:

In a reissue application, new claim 2 is presented for a bread containing chocolate, pepper, **lemon peel** and tomatoes, which provide a unique taste to the bread. The lemon peel is argued to provide softness to the bread. This reissue claim (claim 2) does not contain the "orange peel" that defined over references X and Y in the application. It does, however, require "lemon peel." Both "orange peel" and "lemon peel" are disclosed species of "citrus fruit peel," and the inclusion of a claim to the second disclosed species (the "lemon peel") was overlooked in the prosecution of the patent. Such constitutes "error" upon which reissue may be based. The examiner determines that newly presented claim 2 defines over references X and Y, and the remainder of the art, based upon the "lemon peel."

Resolution of the recapture issue:

Claim 2 is barred by recapture. The limitation omitted in the reissue is "orange peel," and omission of "orange peel" is related to subject matter surrendered in the original application. The presence of the "orange peel" limitation and the resultant sweetness argued in the original application became an integral part of the claim, and a bread absent the "orange peel" limitation and the resultant sweetness has been surrendered. Claim 2 has the alternative species "lemon peel," but it omits the "orange peel" limitation with its resultant sweetness. Accordingly, even though claim 2 is narrower in that it requires the lemon peel limitation, there is impermissible recapture, and claim 2 should be rejected under 35 U.S.C. 251, as such.

CONSULTING T.C. SPRE IN CASE OF DOUBT

The above examples provide guidance in common fact situations involving recapture issues which may arise. Where variants of these fact situations arise for which the examiner is unsure of their resolution, the Special Program Examiner(s) of the Technology Centers should be consulted.

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by placing the sheet face down in the file and placing a large "X" on the back of the sheet. The new sheet should be inserted in place of the turned over existing sheet.

- (E) If any drawing change request is not approved or if any submitted sheet of formal drawings is not entered, the examiner will so inform the reissue applicant in the next Office action, and the examiner will set forth the reasons for same.

1414 Content of Reissue Oath/Declaration

37 CFR 1.175. Reissue oath or declaration.

(a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.

(b)

(1) For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:

(i) With any amendment prior to allowance; or

(ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will